

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1, 2, 5-8 and 10 have been canceled without prejudice or disclaimer. No new matter is being presented, and approval and entry are respectfully requested.

Claims 3, 4, 9 and 11-13 have been allowed and are pending and under consideration. Reconsideration is respectfully requested.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicant request entry of this Rule 116 Response and Request for Reconsideration because:

It is believed that the cancellation of claims 1, 2, 5-8 and 10 puts this application into condition for allowance as suggested by the Examiner.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." ( Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**REJECTION UNDER 35 U.S.C. §112:**

In the Office Action, at pages 4-7, numbered paragraph 5, claims 1, 5, 7, 8 and 10 were rejected under 35 U.S.C. §112, first paragraph, for the reasons set forth therein.

Claims 1, 5, 7, 8 and 10 have been cancelled without prejudice or disclaimer. Hence, the rejection of claims 1, 5, 7, 8 and 10 under 35 U.S.C. §112, first paragraph, is now moot.

**REJECTION UNDER 35 U.S.C. §103:**

A. In the Office Action, at pages 8-13, numbered paragraph 7, claims 1, 2, 5-7 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 2002-107972 (JP '972), as evidenced by Grant & Hackh's Chemical Dictionary, page 277 and the CRC Handbook of Chemistry and Physics, 48th edition, page B-177; combined with USPN 6,355,390 B1 (Yamanami), as evidenced by applicant's admission that melamine is a

thermosetting resin and that titanium oxide can be used as the fine particles that perform the functions of scattering exposed light and transporting photo-generated charges to the substrate disclosed in paragraph 0030 of the instant specification (applicant's admission I). The reasons for the rejection are set forth in the Office Action and therefore not repeated.

Claims 1, 2, 5-7 and 10 have been cancelled without prejudice or disclaimer. Hence, the rejection of claims 1, 2, 5-7 and 10 under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent 2002-107972 (JP '972), as evidenced by Grant & Hackh's Chemical Dictionary, page 277 and the CRC Handbook of Chemistry and Physics, 48th edition, page B-177; combined with USPN 6,355,390 B1 (Yamanami), as evidenced by applicant's admission that melamine is a thermosetting resin and that titanium oxide can be used as the fine particles that perform the functions of scattering exposed light and transporting photo-generated charges to the substrate disclosed in paragraph 0030 of the instant specification (applicant's admission I) is now moot.

B. In the Office Action, at pages 13-16, numbered paragraph 8, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP '972, as evidenced by Grant & Hackh's Chemical Dictionary, page 277 and the CRC Handbook of Chemistry and Physics, 48th edition, page B-177; combined with USPN 6,355,390 B1 (Yamanami), as evidenced by applicant's admission I, as applied to claim 1 above, further combined with USPN 5,302,479 (Daimon), as evidenced by the DERWENT abstract Acc. No. 1992-392116.

Claim 8 has been cancelled without prejudice or disclaimer. Hence, the rejection of claim 8 under 35 U.S.C. §103(a) as being unpatentable over JP '972, as evidenced by Grant & Hackh's Chemical Dictionary, page 277 and the CRC Handbook of Chemistry and Physics, 48th edition, page B-177; combined with USPN 6,355,390 B1 (Yamanami), as evidenced by applicant's admission I, as applied to claim 1 above, further combined with USPN 5,302,479 (Daimon), as evidenced by the DERWENT abstract Acc. No. 1992-392116 is now moot.

C. In the Office Action, at pages 16-17, numbered paragraph 9, claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over JP '972, as evidenced by Grant & Hackh's Chemical Dictionary, page 277 and the CRC Handbook of Chemistry and Physics, 48th edition, page B-177; combined with USPN 6,355,390 B1 (Yamanami), as evidenced by applicant's admission I, as applied to claim 1 above, further combined with USPN 6,180,301 (Mayo).

Claim 8 has been cancelled without prejudice or disclaimer. Hence, the rejection of claim 8 under 35 U.S.C. §103(a) as being unpatentable over JP '972, as evidenced by Grant & Hackh's Chemical Dictionary, page 277 and the CRC Handbook of Chemistry and Physics, 48th edition, page B-177; combined with USPN 6,355,390 B1 (Yamanami), as evidenced by

applicant's admission I, as applied to claim 1 above, further combined with USPN 6,180,301 (Mayo) is now moot.

**ALLOWABLE CLAIMS:**

Claims 3, 4, 9, and 11-13 were allowed. Applicant thanks the Examiner for her careful consideration and allowance of claims 3, 4, 9, and 11-13.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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